

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

**PARTHENON UNIFIED MEMORY
ARCHITECTURE LLC**

Plaintiff,

v.

**HTC CORPORATION AND HTC
AMERICA, INC.**

Defendants.

§ **CASE NO. 2:14-cv-00690-RSP
(Lead Case)**

§ **JURY TRIAL DEMANDED**

**DEFENDANTS HTC CORPORATION AND HTC AMERICA, INC.’S NOTICE OF FINAL
WRITTEN DECISIONS BY PATENT TRIAL AND APPEAL BOARD FINDING
UNPATENTABLE ALL ASSERTED CLAIMS OF U.S. PATENT NOS. 5,812,789 AND
5,960,464**

Pursuant to the Court’s Order of January 10, 2017 continuing the stay in this action, Defendants HTC Corporation and HTC America, Inc. (collectively, “HTC”), hereby provide notice of the Final Written Decisions by the Patent Trial and Appeal Board (“Board”) in *Apple, Inc., HTC Corporation and HTC America, Inc. v. Parthenon Unified Memory Architecture LLC*, IPR2016-00923/U.S. Patent No. 5,812,789 (“the ‘789 patent”)¹ and IPR2016-00924/U.S. Patent No. 5,960,464 (“the ‘464 patent”)² and a status report.

In the Final Written Decisions, entered on August 4, 2017, and attached hereto as Exhibits 1 and 2, the Board “ORDERED that claims 1, 3-6, 11, and 13 of the ‘789 patent are held to be unpatentable.” (Ex.1, p. 45) (emphasis in original); and “ORDERED that claims 1-4, 7-13, 16-24, 32-36, and 40 of the ‘464 patent are determined to be *unpatentable*.” (Ex. 2, p. 36.)

¹ IPR2016-00847 filed by HTC was joined to IPR2016-00923 filed by Apple.

² IPR2016-00848 filed by HTC was joined to IPR2016-00924 filed by Apple.

(emphasis in original). The claims found unpatentable include all claims of the ‘789 and ‘464 patents identified by PUMA as asserted for trial against HTC. (Dkt. 252 at §F.1).

The Board previously found unpatentable all claims of the ‘368, ‘045 and ‘753 patents identified by PUMA as asserted for trial against HTC. (Dkt. 267).

On September 28, 2017, PUMA filed a notice of appeal with the U.S. Court of Appeals for the Federal Circuit of the Board’s decision of unpatentability in IPR2016-00923/IPR2016-00847 with respect to the ‘789 patent. (CAFC Case No. 17-265, Dkt. 1). PUMA’s opening brief is due January 8, 2018. PUMA advised the Board on September 21, 2017, that it did not intend to file a notice of appeal of the decision of unpatentability in IPR2016-00924/IPR2016-00848 on the ‘464 patent and the time to file a notice of appeal has expired. PUMA did not file a notice of appeal of the earlier Final Written Decisions on the ‘368, ‘045 or ‘753 patents. As a result of these actions, of the five patents PUMA identified as asserted for trial against HTC, all of which subsequently were found unpatentable by the Board, only the asserted claims of the ‘789 patent are the subject of PUMA’s appeal to the Federal Circuit.

HTC filed on January 5, 2017, IPR petitions (IPR2017-00512 and IPR2017-00513) and motions for joinder to IPR2016-01135/U.S. Patent No. 5,812,789, and IPR2016-01121/U.S. Patent No. 5,960,464, filed by Apple Inc. The Board granted HTC’s joinders and petitions to institute trial on June 1, 2017. On September 19, 2017, the PTAB terminated IPR2016-01135 and IPR2016-01121 as to Apple only on the basis of a settlement between PUMA and Apple.

On September 22, 2017, the Board issued an Order vacating the decision to institute IPR2016-01121/IPR2017-00513 as to the challenged claims of the ‘464 patent and IPR2016-01135/IPR2017-00512 as to claims 1, 3-6, 11 and 13 of the ‘789 patent on the grounds that 35 U.S.C. Section 318(a) does not require the Board “to issue a *second* final written decision with

respect to the patentability of any claim challenged by HTC” since those claims had been found unpatentable in the IPRs decided on August 4, 2017 (emphasis in original). The PTAB did not dismiss the second ‘789 IPR as to claims 2, 7, 8, 12 and 14 since those claims were not at issue in the first IPR against the ‘789 patent (IPR2016-01135/IPOR2017-00512). Those remaining claims were not asserted against HTC in this action. On October 6, 2017, the PTAB terminated the remaining portion of the second IPR against the ‘789 patent on the basis of a settlement of the remaining portion of the IPR that included PUMA’s grant to HTC of a covenant not to sue on the remaining challenged claims. The termination concluded the last of the pending proceedings before the Board with respect to any of the patents asserted in this action. The only pending proceeding related to the IPRs is PUMA’s appeal before the Federal Circuit of the Board’s finding of unpatentability of the asserted claims of the ‘789 patent in IPR2106-00923/IPR2016-00847.

Dated: November 15, 2017

/s/ Curt Holbreich

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CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of the above and foregoing document has been served by electronic mail on November 15, 2017, to all counsel of record who are deemed to have consented to electronic service.

/s/ *Curt Holbreich*

Curt Holbreich